REMARKS

In the Office Action mailed March 18, 2003, Claims 1-11 are rejected under 35 U.S.C. 103 (a) as being unpatentable over applicant's admitted prior art in view of US Patent 5,809,331 to Staats et al. (referred to herein as the "'331 patent."). Applicant has amended independent claims 1,5,7, and 9 to more clearly claim the subject matter of the present invention. Applicant also respectfully offers the following arguments to rebut Examiner's arguments stated in the Office Action mailed March 18, 2003.

I. Applicant asserts that the Examiner has failed to make a prima facie showing of obviousness. The third requirement of an obviousness rejection under 35 USC 103(a) as explicitly stated in MPEP 2143, that the prior art references must teach or suggest all the claim limitations.

The Examiner states that the standard for obviousness does not require a suggestion to combine references. Applicant directs Examiner's attention to section 2143 of the Manual of Patent Examining Procedure, which states:

MPEP 2143 BASIC REQUIREMENTS OF A PRIMA FACIE CASE OF OBVIOUSNESS
To establish a prima facie case of obviousness, three basic criteria **must** be met. First, there must be some suggestion or motiviation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT IN THE APPLICANT'S DISCLOSURE.**

A. The prior art references do not teach or suggest all of the claim limitations of independent claims 1, 5, 7 and 9.

Applicant asserts that none of the references, either the admitted prior art or the Staats reference (U.S. Patent 5,809,331) show the limitation of **multiple link devices in the same physical module** by **presenting individual or distinct configuration ROMs for each link device to the serial bus**.

Examiner cites the following language from the present application at page 4, lines 9-20 as teaching creating a configuration ROM image for each link device, and presenting said configuration ROM image for each link device:

According to the prior art, a serial bus module may include one or more nodes. For example, FIG. 2 illustrates a typical module device 1 having first and second nodes 2a, 2b. Nodes 2a, 2b include respective link layer services (LINK) 3a, 3b and physical layer services (PHY) 4a, 4b. Each link device 3a, 3b includes a respective global unique identifier (GUID) 5a, 5b to identify each node device 2a, 2b. Presently, the configuration ROM described above is managed by software operating at the transaction layer 6 in module 1. However, current transaction layer implementations which support multiple link devices (such as depicted in FIG. 2) **present a single configuration ROM image 7 for both link devices**.

Staats, Column 4, lines 53-61 reads:

For an embodiment conforming to the IEEE 1394 Serial Bus Standard, each transaction capable node 12, 15, 16, 24, 32, 34, 40 and 44 of the serial bus implements a configuration ROM. The configuration ROM is a nonvolatile memory which stores critical boot information which is accessed during bus initialization as described below. The boot information is stored in the Name Registry and used to identify the appropriate driver software to be loaded for the node of interest.

Applicant asserts that the Examiner has overlooked a limitation of claim 1, namely **creating a configuration ROM image for each link device, and presenting said configuration ROM image for each link device.** As each element of the independent claims 1,5,7, and 9 are not disclosed or suggested by the cited reference and Applicant's admitted prior art, the third test for obviousness as required under MPEP section 2143 has not been met, and a rejection based on 35 USC 103(a) was improper.

B. Applicant asserts that any suggestion to combine references comes from Applicant's disclosure, not the cited reference or Applicant's admitted prior art. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT IN THE APPLICANT'S DISCLOSURE.

Applicant asserts that the Examiner has employed hindsight in rejecting claims 1-11 in the present application. The admitted prior art, as illustrated in FIG. 2 of the present application **does not show** multiple link devices within a single node. Similarly , Staats does not show multiple link devices within a single node. In fact, Staats in FIG. 2, illustrates nodes as having single configuration ROMS only. Staats does disclose multiple logical units being associated with a single node at Column 2, lines 43-50.

Staats, at Column 2, lines 43-50 reads:

The present invention may be applied to any arbitrarily assembled collection of nodes linked together as in a network of devices. It must also be noted that it is necessary to distinguish a node from a logical unit. Each node to reside on the bus will have associated with it at least one logical unit. In certain circumstances, **a given node may be associated with multiple logical units.** Usually however, there will be a one-to-one correspondence between logical units and nodes on the bus.

However, there is no mention of multiple configuration ROMS being needed for such an arrangement of nodes and logical units. While Staats refers to the association of multiple config ROMs to a single node, **Staats does not indicate that this is a problem.** Applicant's claims are directed toward a node having multiple link devices, each having ITS OWN config ROM. The problem with having only a SINGLE config ROM for multiple devices is disclosed in Applicant's disclosure, and nowhere in Applicant's admitted prior art or in Staats.

On the basis of the above remarks, early consideration of this application and early allowance are respectfully requested. Applicant requests a one-month extension to respond to the Office Action mailed March 18, 2002 and includes the fee for the one month extension.

Respectfully submitted,
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